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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,259	04/02/2004	Donald L. Gadberry	A-3099-AL	1789

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EXAMINER

EREZO, DARWIN P

ART UNIT	PAPER NUMBER
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3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary	Application No. 10/817,259	Applicant(s) GADBERRY ET AL.	
	Examiner Darwin P. Erez	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/2/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, drawn to a surgical clip, classified in class 606, subclass 157.
 - II. Claim 13, drawn to a method of manufacturing a surgical clip, classified in class 264, subclass 328.16.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the surgical clip of Invention I can be made machining a block copolymer or metal.
3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Patrick Ikehara on 3/28/07 a provisional election was made without traverse to prosecute the invention of Invention I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action. Claim 13 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

8. The information disclosure statement (IDS) submitted on 09/02/2005 has been received and made of record. Note the acknowledged form PTO-1449 enclosed herewith.

Specification

9. The abstract of the disclosure is objected to because of its undue length. The abstract should be in narrative form and generally limited to a single paragraph on a

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separate sheet within the range of 50 to 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-3, 5-9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,931,058 to Cooper.

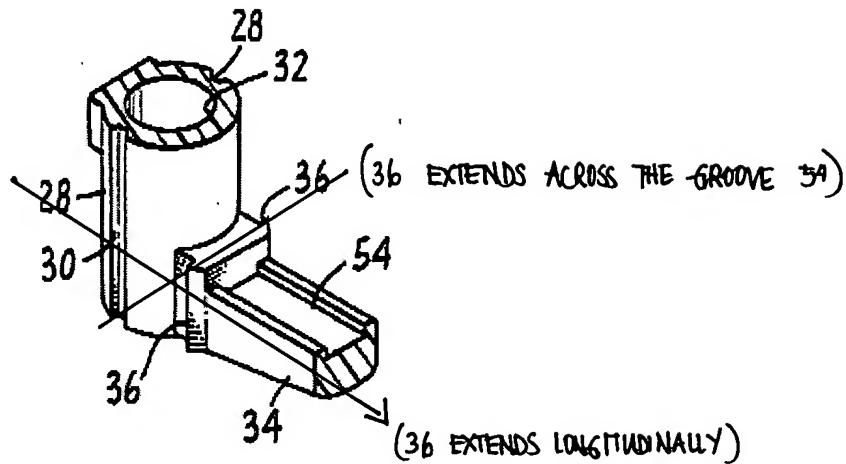
(claim 1) The entire disclosure of the Cooper reference discloses the claimed invention. For example, Cooper discloses a surgical clip adapted for use in holding a suture (see Fig. 4), the clip comprising:

a housing having an outer surface (see Fig. 4);

a pair of jaws **20,34** extending longitudinally from the housing in an opposing relationship with each other;

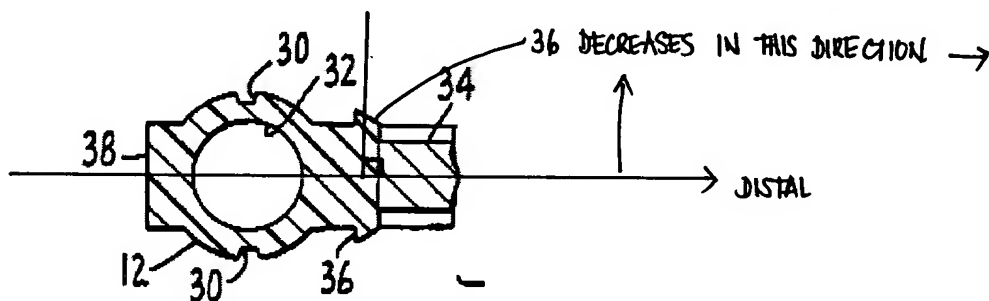
a resilient pad **50** carried by one of the jaws and defining with the outer surface of the housing a cavity (cavity is shown in Fig. 7, where reference number 54 is directed towards); and

at least one rib **36** extending longitudinally of the housing (see figure below) and across the cavity to inhibit passive of the suture into the cavity.



(claim 2) The surface of the pad **50** that comes in contact with the groove **54** is viewed as the proximal end wall.

(claim 3) One jaw has a proximal end and a distal end (as shown in the figure below; and the rib has a height measured perpendicular to the one jaw, which decreases with progressive distal positions along the one jaw.



(claim 5) The opposing jaw has an open position and a closed position (Fig. 1), and a spring **42** disposed in the housing and having properties for biasing the opposing jaws to the closed position.

(claim 6) Cooper discloses a surgical clip adapted for use in holding a suture, comprising:

a housing formed by an inner member **12** and an outer member **14** having a telescoping relationship (see Fig. 1 for the telescoping mechanism);

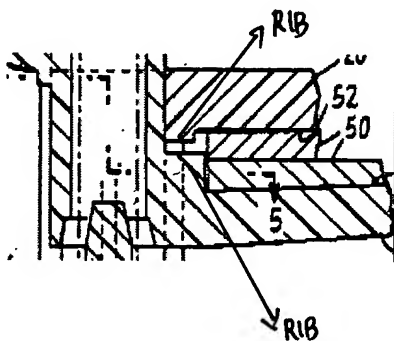
a first jaw **34** extending from the inner member outwardly of the housing and having a first inner surface;

a second jaw **20** extending from the outer member outwardly of the housing and having a second inner surface;

the jaws being movable between an open position and a closed position in an opposing relationship with the first surface of the first jaw facing the second surface of the second jaw (see Fig. 1);

at least one first rib **36** extending from the first surface of the first jaw **34** toward the second surface of the second jaw; and

at least one second rib extending from the second surface of the second jaw **20** toward the first surface of the first jaw (see attached Fig. 4 below).



(claim 7) As shown above, the first rib of the first jaw is offset from the second rib of the second jaw.

(claim 8) The first rib **36** has a dimension measured perpendicular to the first surface that is at a maximum in proximity to the inner member of the housing.

(claim 9) The first rib **36** has a height which decreases with progressive positions along the first jaw, as recited in claim 3.

(claim 12) The first rib is integral with the inner member of the housing and the second rib is integral with the outer member of the housing (see Fig. 4).

12. Claims 6-8 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,817,604 to Smith, III.

(claim 6) Smith discloses a surgical clip adapted for use in holding a suture, comprising:

a housing formed by an inner member **21** and an outer member **20** having a telescoping relationship (see Fig. 2 for the telescoping mechanism);

a first jaw **22** extending from the inner member outwardly of the housing and having a first inner surface;

a second jaw **23** extending from the outer member outwardly of the housing and having a second inner surface;

the jaws being movable between an open position and a closed position in an opposing relationship with the first surface of the first jaw facing the second surface of the second jaw (see Fig. 2);

at least one first rib on the first jaw surface **31** of the first jaw **22** toward the second surface of the second jaw; and

at least one second rib on the second jaw surface **31** of the second jaw **22** toward the first surface of the first jaw.

(claims 7, 10 and 11) Smith discloses at least one rib on the first surface **31** of the first jaw and at least two ribs laterally offset from the second surface **31** of the second jaw (see Fig. 2 for the offset position).

(claim 8) The first rib of the first surface **31** is in close proximity to the inner member.

(claim 12) The first rib is integral with the inner member of the housing and the second rib is integral with the outer member of the housing (see Fig. 2).

Conclusion

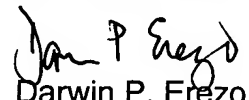
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez who's telephone number is (571) 272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Darwin P. Erez
Examiner
Art Unit 3731

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